MARKED-UP VERSION

1. (Twice Amended) A method for displaying on a viewer information processing system with an interface to a display, a set of multimedia segments to form a multimedia presentation, the method comprising the steps of:

receiving a play-list and program content from a program provider, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation and wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user;

receiving from the program provider the multimedia segments required by the play-list; and

receiving the multimedia presentation on the display by rendering the multimedia segments as directed by the play-list.

11. (Twice Amended) A method for distributing program content from a program provider over a telecommunications infrastructure to a plurality of clients capable of receiving program content broken into a plurality of multimedia segments forming a multimedia presentation, the method on a program provider comprising the steps of:

breaking program content into a plurality of multimedia segments;

transmitting at least one play-list and program content to at least one client, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation and wherein the playlist is based on preferences set by a program provider without the need to receive preferences from a user; and

transmitting the multimedia segments required by said play-lists that form the multimedia presentation.

18. (Twice Amended) A computer readable medium comprising programming instructions for displaying on a viewer information processing system with an interface to a display, a set of multimedia segments to form a multimedia presentation, the programming instructions comprising

receiving a play-list and program content from a program provider, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a

multimedia presentation and wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user;

receiving from the program provider the multimedia segments required by the play-list; and

displaying the multimedia presentation on the display by rendering the multimedia segments as directed by the playlist.

28. (Twice Amended) A viewer information processing system with an interface to a display, for receiving a set of multimedia segments to form a multimedia presentation, the viewer information system comprising

a receiver for receiving a play-list and program content from a program provider wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation and wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user;

a receiver for receiving the multimedia segments from the program provider;

a means for rendering the multimedia segments into a multimedia presentation as directed by the play-list; and

an interface to a display for displaying said multimedia presentation.

REMARKS

Applicants have studied the Office Action dated March 31, 2003. It is submitted that the application is in condition for allowance. Claims 1, 11, 18 and 28 have been amended. Claims 1 - 33 are pending in view of the above amendments. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks are respectfully requested. In the Office Action, the Examiner:

- rejected claims 1, 3-5, 7, 9, 11, 14-16, 18, 20-22, 24, 26, 28, and 30-32 under 35 U.S.C. § 102(e) as being anticipated by Abecassis (U.S. 5,664,046);
- rejected claims 2, 19, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. 5,664,046) in view of Siedman et al., (U.S. 6,298,482);
- rejected claims 6, 10, 13, 17, 23, 27, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. 5,664,046) in view of Logan et al., (U.S. 5,732,216); and
- rejected claims 8, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. 5,664,046) in view of Balakrishnan et al., (U.S. 6,473,903).

Final Office Action Is Inappropriate In View of Newly Cited Art of Abecassis, Logan, Balakrishnan

Applicants have studied the Office Action dated March 31, 2003. Applicants respectfully request entry of these remarks under the provisions of 37 C.F.R. § 1.116(a) in that the remarks below place the application and claims in condition for allowance, which allowance is respectfully requested. Claims 1 - 33 are pending. Reconsideration and allowance of the claims in view of the following remarks are respectfully requested. As an initial matter, the Examiner made the Office Action final based on a new ground of rejection not stated in the earlier Office Action. Applicants respectfully traverse this decision. In the Final Office Action, the Examiner rejects the present claims by citing Abecassis in view of Logan, and Abecassis in view of Balakrishnan. The Applicants respectfully point out that the references of Abecassis, Logan, and Balakrishnan were not cited in the previous Office Action.

According to MPEP § 706.07(a): "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection not necessitated by amendment of the application by applicant, whether or not the prior art is already of record." In the previous Office Action dated October 23, 2002, the Examiner rejected claims 1-5, 8-16, 18-22, and 25-32 under 35 U.S.C.§ 102(e) as being anticipated by Seidman and claims 6, 7, 17, 23, 24, and 33 under 35 U.S.C.§ 103(a). In the previously-filed amendment, Applicants amended the independent claims 1, 11, 18, and 28 for clarity and to include an additional limitation of "receiving a playlist from a program provider." The Applicants did not switch from one subject matter to another or resort to any subterfuge to keep the application pending.[1] Thus it is respectfully submitted that the final status of the Office Action is premature and should be withdrawn.

If the Examiner does not withdraw the final status of the Office Action, Applicants submit that this response does not raise new issues in the application. It is submitted that the present response places the application in condition for allowance or, at least, presents the application in better form for appeal. Entry of the present response is therefore respectfully requested.

Overview of the Current Invention

Preferred Embodiments of the present invention provide an apparatus, method and computer readable medium for enabling program providers, such as a cable company, to tailor advertisements and commercials to individual users. The program provider, through market demographics, is able to target commercials to individual users watching the same program content (i.e. television shows). For example, during a football game, the program provider (e.g. cable company) using the present invention targets demographically various viewers. In this example, the program provider targets viewers under eighteen with sport commercials; viewers eighteen to thirty-five with beer commercials; and viewers over thirty-five with season ticket commercials. The program

[1] See MPEP § 706.07.

providers put together a playlist of commercials. Please note that the commercials do not have to be related to any specific program content being rendered; so returning to the example above, an eighteen year old may be watching one program while the second viewer is watching a different program. The playlist for commercials is targeted to the user - - not to the program.

The present invention includes receiving a play-list and program content (i.e. television shows) from a program provider, wherein the play-list is a list of instructions for rendering each of the multimedia segments received and the sequence of the multimedia segments in the play-list is directed by the program provider and wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user. The provider of the playlist based on user/viewer demographics sets the user preferences. The present invention does not require that the user select any preferences while watching the program content.

The program provider transmits program content (e.g., television programs) and play-lists to coordinate the display of the multimedia segments received at viewers' units (e.g., a set-top box coupled to a television receiver or an information processing apparatus with a display). The program provider obtains information from, or about, its customers that is of great use in determining what content to provide to its viewers. The program provider transmits play-lists that are recognized at the viewer's unit and used to select multimedia segments for display to the viewer. Thus, Applicants' invention represents a new business model for tailoring and delivering multimedia segments in a network such as a cable network or a public data network such as the Internet. The program provider tailors and charges for multimedia segments tailored to a viewer.

In order to more particularly point out this feature of "receiving a play-list and program content (i.e. television shows) from a program provider" and "wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user", the following language has been added the independent

claims, i.e., claims 1, 11, 18, and 28 as follows:

- Claims 1, 11, and 18

  receiving a play-list and program content from a program provider, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation and wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user;

- Claim 28

  a receiver for receiving a play-list and program content from a program provider wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation and wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user;

Rejection under 35 U.S.C. §102(e)

As noted above, the Examiner rejected claims 1, 3-5, 7, 9, 11, 14-16, 18, 20-22, 24, 26, 28, and 30-32 under 35 U.S.C. § 102(e) as being anticipated by Abecassis (U.S. 5,664,046). Independent claims 1, 11, 18 and 28 have been amended to distinguish over Abecassis. The Examiner at page 2 of the Office Action correctly states *"Regarding claims 1 and 9 Abecassis [...] The hardware/software 703 retrieves from subscriber video system as subscriber's video content preferences."* However, the independent claims of the present invention are directed to receiving a play-list and program content from a program provider. The playlist is not based on user input as taught and described by Abecassis but rather "the playlist is based on preferences set by the program provider without the need to receive preferences from a user." Accordingly, the present invention enables the provider of the program content to select the multimedia segments such as commercials that are viewed on a user's system. This is not the same as having the user enter "subscriber video content preferences" as taught and described by Abecassis.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected

claims as being anticipated by Abecassis.[2] The elements in independent claims 1, 11, 18, and 28 of "receiving a play-list and program content from a program provider" and "wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user" are not taught or disclosed by Abecassis. Accordingly, the present invention distinguishes over Abecassis for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome.

Independent claims 1, 11, 18, and 28 have been amended to distinguish over Abecassis. Claims 3-5, 7, 9, 14-16, 20-22, 24, 26, and 30-32 depend from independent claims 1, 11, 18, and 28 respectively, since dependent claims contain all the limitations of the independent claims, claims 3-5, 7, 9, 14-16, 20-22, 24, 26, and 30-32 distinguish over Abecassis, as well.

Rejection under 35 U.S.C. §103(a) over Abecassis in view of Siedman

As noted above, the Examiner rejected claims 2, 19, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. 5,664,046) in view of Siedman et al., (U.S. 6,298,482). As the Examiner correctly notes on page 5 of the Office Action *"Regarding claim 2 Abecassis fails to disclose storing files prior to presenting segments."* The Examiner goes on to combine Abecassis with Seidman.[3]

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[2] See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

[3] Applicants make no statement whether such combination is even proper

The Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such as the proposed modification, it is not proper and the *prima facie* case of obviousness cannot be properly made. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Here the solution taught by Abecassis taken along and/or in view of Seidman does not allow the program provider to control the play list through ""receiving a play-list and program content from a program provider" and "wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user." As noted above the Abecassis references as pointed out by the Examiner teaches that the user enter "subscriber video content preferences." In contrast the present invention enables the program provider to select the multimedia segments such as commercials that are viewed on a user's system. The Seidman reference discloses that the user selects objects (i.e., a play-list) for a personalized view. Again this is not the same as playlist generated by the program provider and transmitted to the set-top boxes of the user. Accordingly, independent claims 1, 18 and 28 of the present invention distinguish over Abecassis taken alone and/or in view of the Seidman for this reason as well.

Continuing further, when there is no suggestion or teaching in the prior art for having the program provider provide the "wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user" including which commercials previously delivered to be rendered the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art references of Abecassis and Seidman do not even suggest, teach or mention this type of control over advertisement by the program provider. Accordingly, independent claims 1, 18 and 28 of the present invention distinguish over

Abecassis taken alone and/or in view of the Seidman for this reason as well.

As discussed above, independent claims 1, 18, and 28 distinguish over the Abecassis taken alone and/or in view of Seidman reference. Claims 2, 19 and 29 depend from claims 1, 18, and 28 respectfully. Since dependent claims contain all the limitations of the independent claims, claims 2, 19 and 29 distinguish over the Abecassis taken alone and/or in view of Seidman reference, as well

Additionally, the Examiner is reminded the Seidman reference is commonly assigned with the present invention to International Business Machines Corporation of Armonk New York. The present invention has an assignment recorded at Reel 10295/ Frame 0841 to the Assignee, International Business Machines Corporation. Under MPEP 715.01(b):

> Where, however, [...], in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103 using the reference patent, a showing that the invention was commonly owned at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. >See MPEP § 706.02(l) and §706.02(l)(1).

Accordingly, the Examiner is reminded that the mere filing of a continuation application or RCE will remove this commonly owned reference under a 35 U.S.C. 102(e)/103 rejection for claims 2, 19 and 29 for this reason as well.

Rejection under 35 U.S.C. §103(a) over Abecassis in view of Logan

As noted above, the Examiner rejected claims rejected claims 6, 10, 13, 17, 23, 27, and 33 under 35 U.S.C. § 103(a) as unpatentable over Abecassis (U.S. 5,664,046) in view of Logan et al., (U.S. 5,732,216). As the Examiner correctly notes on page 6 of the office action *"Regarding claim 6 [...] Abecassis fails to a modem connected to an Internet."* The Examiner goes on to combine Abecassis with Logan.[4] As noted above,

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[4] Applicants make no statement whether such combination is even proper.

the elements in independent claims 1, 11, 18, and 28 of "receiving a play-list and program content from a program provider" and "wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user" is not taught or disclosed by Abecassis taken alone and/or in view of Logan. Accordingly, the present invention distinguishes over Abecassis taken alone and/or in view of Logan for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 103(a) has been overcome.

Independent claims 1, 11, 18, and 28 have been amended to distinguish over Abecassis taken alone and/or in view of Logan. Claims 6, 10, 13, 17, 23, 27, and 33depend from independent claims 1, 11, 18, and 28 respectively, since dependent claims contain all the limitations of the independent claims, claims 6, 10, 13, 17, 23, 27, and 33 distinguish over Abecassis taken alone and/or in view of Logan, as well.

Rejection under 35 U.S.C. §103(a) over Abecassis in view of Balakrishnan

As noted above, the Examiner rejected claims rejected claims rejected claims 8, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Abecassis (U.S. 5,664,046) in view of Balakrishnan et al., (U.S. 6,473,903). As the Examiner correctly notes on page 7 of the Office Action *"Regarding claim 8 Abecassis fails to disclose receiving segments of advertisement."* The Examiner goes on to combine Abecassis with Balakrishnan.[5] As noted above, the elements in independent claims 1, 11, 18, and 28 of "receiving a play-list and program content from a program provider" and "wherein the playlist is based on preferences set by the program provider without the need to receive preferences from a user" is not taught or disclosed by Abecassis taken alone and/or in view of Logan. Accordingly, the present invention distinguishes over Abecassis and/or in view of Balakrishnan for at least this reason. The Applicants respectful submit that the Examiner's rejection under 35 U.S.C. § 103(a) has been overcome.

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[5] Applicants make no statement whether such combination is even proper.

Independent claims 1, 11, 18, and 28 have been amended to distinguish over Abecassis taken alone and/or in view of Balakrishnan. Claims 6, 10, 13, 17, 23, 27, and 33depend from independent claims 1, 11, 18, and 28 respectively, since dependent claims contain all the limitations of the independent claims, claims 6, 10, 13, 17, 23, 27, and 33 distinguish over Abecassis taken alone and/or in view of Balakrishnan, as well.

CONCLUSIONS

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

In view of the foregoing, Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted.

Dated: June 2, 2003 By: _____

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